

## REMARKS

### Status of the Application

Claims 1-20 were pending in the application at the time the Office Action was mailed. All claims have been rejected. No claims have been added. Therefore, claims 1-20 remain pending and before the examiner for consideration.

### Rejections Under 35 U.S.C. 103

Claims 1-20 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Application No. US 2004/0137077 to Ancira et al. ("007"), International Patent Application No.: WO 94/15626 to Rech, and U.S. Patent No. 6,300,369 to Ancira ("369"). According to the Office Action:

'077 teach a composition for the treatment of seborrheic keratoses, hyperpigmentation and other skin conditions associated with seborrheic keratoses, comprising applying at least one or more of melanin inhibitors. Among the melanin inhibitors, '077 teach instant claimed kojic acid, arbutin and phytic acid [0034]. In particular, the composition of example C of '077 recites a combination of melanin inhibitors, Kojic acid and arbutin. Thus, it is known in the art to employ a combination of melanin inhibitors for the treatment of hyperpigmentation. '077 fail to teach Vismia of the instant claims.

WO teaches a cosmetic composition containing Vismia extract, which is used for promoting collagen synthesis, particularly for skin aging or enhancing skin firmness (abstract). WO does not teach a combination of the claimed components or the treatment of hyperpigmentation with Vismia.

'369 teach a skin peel composition comprising kojic acid as the primary active agent for the treatment of hyperpigmentation or melanocytic hyperactivity (col. 2, lines 30 through col. 3, lines 24). In addition to treating hyperpigmentation, '369 teach including compounds that provide the barrier protection effects, protect mechanical properties of stratum corneum and acceleration of collagen formation (col. 3). '369 does not teach Vismia of instant claims but teaches obtaining a synergistic beneficial effect of treating aged, photo damaged and hyperpigmented skin by combining the skin lightening, skin peeling treatments (col. 8, L 7-21).

Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to include the collagen stimulating Vismia extract of WO in the skin-lightening composition of '077 containing a combination of kojic acid, phytic acid and arbutin (all of them directed to hyperpigmentation) because '369 suggests combining the treatment of hyperpigmentation as well as anti-aging so as to achieve a beneficial combination effect in one treatment. Further, optimizing the amounts of individual components with an expectation of achieving a combination of beneficial effects i.e., treatment for aging as well as hyperpigmentation would have been within the scope of a skilled artisan.

These rejections are incorrect for at least two reasons. First, the '007 reference is not a proper 103 reference because it was filed October 9, 2003, after the priority date of the present application (July 22, 2003) and was filed after November 29, 2000, and is not prior art under 35 U.S.C. § 102(a), (b), or (e). See MPEP §706.02(a). Although the '007 reference is a continuation-in-part of application no. 10/072,829 filed February 8, 2002, the subject matter used in the rejection must be disclosed in the earlier-filed application in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e). Earlier-filed application no. 10/072,829 does not disclose phytic acid or vismia. See 706.02(f)(1). Second, the remaining references do not render the invention obvious within the meaning of 35 U.S.C. 103 because the combination of '369 and WO 94/15626 fails to teach or suggest all the claim limitations.<sup>1</sup> Independent claims 1, 12, 16, 17, 19, and 20 recite a topical composition comprising both vismia and phytic acid. Neither the abstract of WO 94/15626 nor the '369 reference mentions phytic acid.

For the reasons cited above, withdrawal of these rejections and allowance of all pending claims is respectfully requested.

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<sup>1</sup> See MPEP 2143. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references then combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

CONCLUSION

The currently pending claims before the examiner are supported throughout the specification and are patentable over the prior art. No new matter has been added. This application is now in full condition for allowance, and such action is respectfully requested.

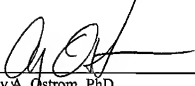
The Commissioner is hereby authorized to charge any underpayment or credit any overpayment of fees under 37 C.F.R. 1.16 or 1.17 as required by this paper to Deposit Account 50-0951.

The examiner is cordially invited to call the undersigned if clarification is needed on any matter within this response, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

AKERMAN SENTERFITT

Date: 1/10/07

  
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Docket No. 9751-1